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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR		ATTORNEY DOCKET NO.
08/690,747	08/01/96	OHTANI	H	07977/052001

IM61/0407

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EXAMINER	
KUNEMUND,R	
ART UNIT	**PAPER NUMBER**
1765	

DATE MAILED: 04/07/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 08/690,747	Applicant(s) Ohtani et al.
	Examiner Robert Kunemund	Group Art Unit 1765

X Responsive to communication(s) filed on *Feb 2, 1999* .

X This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

X Claim(s) *1-3, 5-8, 10-14, and 16-25* is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

X Claim(s) *1-3, 5-8, 10-14, and 16-25* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____ .

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____ .

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- *SEE OFFICE ACTION ON THE FOLLOWING PAGES* ---

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-3, 5-8, 10-14, and 16 to 25 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 5,580,792. Although the conflicting claims are not identical, they are not patentably distinct from each other because the sole difference is the place of etching. However, in the absence of unobvious results, it would have been obvious to one of ordinary skill in the art to determine through routine experimentation the optimum, operable placement of etching in order to remove metal or grain boundaries

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-3, 5-8, 10-14, and 16 to 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakajima et al in view of Gibson.

The Nakajima et al reference teaches a method of silicon crystal growth. On a substrate, a catalyst for growth is applied. Then an amorphous layer is deposited onto the metal, the resulting structure is then annealed in order to crystallize the silicon. The silicon can be patterned to from island. The sole difference between the instant claims and the prior art is the etching. However, the Gibson reference teaches a method of etching silicon layers which have been grown with a catalyst in the area of the catalyst, note col. 3. It would have been obvious to one of ordinary skill in the art to modify the Nakajima et al process by the teachings of the Gibson reference to etch in order to remove the metal catalyst which lower the output of the device formed on such layers.

Claims 1-3, 5-8, 10-14, and 16 to 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patents 5,580,792

The 5,580,792 reference teaches a method of silicon crystal growth. On a substrate, a catalyst for growth is applied. Then an amorphous layer is deposited onto the metal, the resulting structure is then annealed in order to crystallize the silicon. The silicon can be patterned to from island and is etched after the heating step. . The sole difference between the instant claims and the prior art is the etching placement. However, in the absence of unobvious results, it would have been obvious to one of ordinary skill in the art to determine through routine experimentation the optimum, operable placement of the etching in the 5,580,792 reference in order to form the desired island sizes and remove metals.

Response to Applicant's Arguments

Applicant's arguments filed February 1, 1999 have been fully considered but they are not persuasive.

The rejection over the Nakajima et al reference will be maintained until a certified English translation of the foreign priority document has been submitted to the Patent Office and review by the examiner.

Applicants' argument concerning the 5,580,792 patent is noted. However, at col. 3 line 10-15 the reference does teach that the amorphous silicon layer is patterned prior to

crystallization of said layer. Therefore, the rejection over this patent is maintained by the examiner of record. The rejections over the other two patents has been withdrawn in view of applicants arguments.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Kunemund whose telephone number is (703) 308-1091. The examiner can normally be reached on Monday through Friday from 7:00 to 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ben Utech can be reached on (703) 308-3324. The fax phone number for this Group is (703) 305-3599.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

RMK

March 30, 1999